

Please enter the following amendments and remarks:

STATUS OF THE CLAIMS

Claims 1-9, 12-22, 24-31, 33, 34, 36, 38-40 and 42-91 are pending in the Application.

Claims 1-9, 12-22, 24-31, 33, 34, 36, 38-40 and 42-91 have been rejected by the Examiner.

Claims 1, 20, 25, 36, 38, 45, 47, and 49 have been amended.

Reconsideration of the present Application is respectfully requested.

REMARKS

Applicant acknowledges that the objection to the drawings has been withdrawn due to the amendment filed on May 4, 2005. Applicant also acknowledges that the rejection of claims 1-19 and 24-37 under 35 U.S.C. 112, second paragraph have been withdrawn due to the amendment filed on May 4, 2005. Claim 20 is presently objected to because of informalities. Claim 20 has been amended; therefore, Applicant requests that this objection be withdrawn. Claims 1, 25, 36, 38, 45, 47, and 49 have also been amended.

Claims 1-2, 9, 14-21, 24-27, 29-31, 33-34, 36, 38-40, 42-53, 55-58, 62-63, 65-68, 71-88 and 90 have been rejected under 35 U.S.C. 102(e) as being anticipated by Goetz et al. (U.S. 6,421,650). Claims 3-8, 22, and 28 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (U.S. 6,421,650) in view of Edelson et al. (U.S. 5,737,539). Claims 59-60, 89, 12-13, and 91 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (U.S. 6,421,650) in view of Liff et al. (U.S. 5,797,515). Claims 54, 64, 69, and 70 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz

et al. (U.S. 6,421,650) in view of Adams (U.S. 2002/0055856). Claim 61 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz et al. (U.S. 6,421,650) in view of Liff et al. (U.S. 5,797,515) and further in view of Adams (U.S. 2002/0055856). Applicant traverses these rejections for at least the following reasons.

35 U.S.C. § 102

Claims 1-2, 9, 14-21, 24-27, 29-31, 33-34, 36, 38-40, 42-53, 55-58, 62-63, 65-68, 71-88 and 90 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,421,650 ("Goetz"). Applicant respectfully traverses this rejection for at least the following reasons.

According to 102(e), a person shall be entitled to a patent unless:

the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the application for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Anticipation under 35 U.S.C. §102 requires the cited art teach every aspect of the claimed invention. *See, M.P.E.P. §706.02(a)*. In other words, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See, M.P.E.P. §2131 citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

A. Independent claims 1, 20, 25, 36, 38, 45, 47, and 49

Independent claims 1, 20, 25, 36, 38, 45, 47, and 49 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Goetz. Applicant respectfully traverses these rejections for at least the following reasons.

Amended claim 1 reads as follows:

A method comprising:
entering via an electronic prescription creation device a prescription for a drug;
viewing a drug use evaluation alert on a graphical user interface of the electronic prescription creation device;
viewing on the graphical user interface a query of whether a user desires to override the drug use evaluation alert;
entering via the electronic prescription creation device an override of the drug use evaluation alert;
transmitting the prescription and override over a network **directly** to a prescription processor;
wherein the prescription processor, upon receipt of the prescription, attempts to process the prescription and actuates a second drug use evaluation, and if a resultant drug use evaluation alert is correspondent to said override of the user, the prescription processor processes the prescription.

As may be seen in the specification, and as claimed in amended claim 1, the present invention allows a prescriber, such as a physician, to enter a prescription, including an override of a drug use evaluation alert, and transmit the prescription and accompanying override over a network **directly** to a prescription processor. Support for amended claim 1 can be found at least in figure 1 and in paragraph 61 of the specification.

Goetz, however, does not teach a method or system that allows direct communication between a prescriber and a prescription processor. Rather, Goetz teaches a medication management system that requires a patient component, physician component, and a pharmacist component. *See* abstract; column 4, lines 22-24. The patient component provides the link between the physician's component and the pharmacist's component. *See* column 8, lines 59-62.

The physician can enter a prescription for a patient by using the physician's component. *See* column 10, lines 48-50. The prescription is then downloaded to the patient component. *See* column 11, lines 35-38. "The patient then takes the patient component to the pharmacist who then transfers the patient data from the patient component 104 to the pharmacist's PC component for execution of the prescription." Column 11, lines 40-43. Thus, unlike Applicant's invention, Goetz fails to provide a means for communicating the prescription and override of a drug use evaluation alert over a network directly between a prescriber and a prescription processor. The Examiner has acknowledged this fact on page 18 of the Office Action by stating "the Examiner respectfully submits that the patient component in Fig. 6 of Goetz provides a means for communication between a prescriber and prescription processor." If Goetz provided for direct communication between the physician and prescription processor, the patient component would not be necessary.

Applicant's invention does not contemplate the use or involvement of a patient component. Goetz's requirement of a patient component distinguishes the medication management system of Goetz from Applicant's invention. Applicant's invention allows for direct communication between the prescriber and the prescription processor and avoids unnecessary reliance on the patient to make sure that the prescription is delivered to the prescription processor.

In addition, the Examiner has argued that column 11, line 40 through column 12, line 10 of Goetz "discloses the pharmacist utilizing information received from the physician and conducting additional drug evaluations and checking for potential interactions and cautions before prescribing the drug. As such, it is readily apparent that Goetz teaches that the prescription processor utilizes the override from the prescriber and that the pharmacist compares

any alerts it receives with any overrides from the physician.” *See* Office Action at page 19.

Applicant respectfully disagrees. While the cited portion of Goetz may disclose that “a check of potential interactions and cautions concerning a particular prescription is performed in the pharmacist component,” there is no mention or discussion in Goetz that the results of such a check are compared with the override of the user before the prescription is processed. Rather, according to Goetz, “the interaction check in the pharmacist’s computer and in the physician’s component serves a watchdog function only” and can be overridden by either the pharmacist or physician. *See* column 12, lines 5-9. The interactions are then flagged in the patient component. Goetz does not teach or even suggest that an interaction detected by the pharmacist is compared with the user’s override before the prescription is processed. Therefore, Goetz contemplates that the pharmacist can override the interaction check without the consent of the physician.

Because Goetz fails to teach each and every element of Applicant’s invention as set forth in the present Office Action, Applicant respectfully submits that Goetz does not anticipate Applicant’s invention. Applicant respectfully traverses the 35 U.S.C. § 102 (e) rejection with respect to Claim 1 for at least the foregoing reasons. Applicant respectfully submits that Claim 1 is patentably distinguishable over the prior art of record.

Similarly, Applicant respectfully submits that Claims 20, 25, 36, 38, 45, 47, and 49 are not anticipated by the prior art cited for at least the reasons set forth herein with respect to Claim 1.

Applicant respectfully submits that Claims 2- 9, 14-19, 21-22, 24, 26-31, 33-34, 39-40, 42-44, 46, 48 and 50 similarly overcome the prior art, at least because of these claims’ ultimate dependence on patentably distinguishable base Claims 1, 20, 25, 38, 45, 47 and 49.

B. Independent Claims 51, 65, 71, 79, 84, 86, and 88

Independent claims 51, 65, 71, 79, 84, 86 and 88 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Goetz. All of the aforementioned claims relate to dispensing a drug “as written” and the reason why the drug is to be dispensed as written. Reference to Applicant’s disclosure demonstrates that Applicant’s use of the term “as written” refers to the dispensing of brand name drugs versus generic drugs. At paragraph 46 of Applicant’s disclosure, Applicant states that “when a prescriber instructs that a drug is to be dispensed as written, the prescriber is providing instructions to the pharmacy 122 that fills the prescription not to substitute a generic drug for the brand-name drug prescribed in the prescription.” Paragraph 47 of Applicant’s disclosure further states that “if the prescriber 112 does not check the radio button or check box of the dispense as written query 1030 the pharmacy 112 receiving the completed prescription will presume that it can substitute a generic drug for any prescribed brand-name drug.”

While Figure 15 of Goetz does include a check-box entitled “Generic Equivalent,” neither the figure nor the text accompanying this figure describe or teach Applicant’s invention. For example, the Office Action cites to column 10, lines 56-62 which states “The physician selects and taps on the desired medication, in this case, Canderill and taps on Generic Equivalent. The physician then taps on “Get Info” and the screen of Fig. 16 pops up.” There is no further discussion in Goetz regarding prescribing a generic drug. Goetz fails to teach an element of Applicant’s invention, namely, that the reason for prescribing a drug “as written” be entered or selected by the user. Goetz does not teach or contemplate this limitation. This is evidenced by reference to column 11, lines 10-11 and figures 16-20 in which Goetz discusses special instructions that can be selected or entered by a physician. None of the special instructions set

forth in Goetz relate to the reason why the drug needs to be dispensed as written. The reason for prescribing a brand drug may be necessary to ensure that the patient's insurance company will cover the costs of the brand name drugs. Goetz fails to teach this limitation and the present Office Action fails to provide some teaching for this aspect of Applicant's invention.

The present Office Action fails to set forth an element of independent claims 51, 65, 71, 79, 84, 86 and 88; therefore Applicant submits that the present rejection under 102(e) is improper. Wherefore, claims 52-64, 66-70, 72-78, 80-83, 85, and 87 similarly overcome the prior art, at least because of their ultimate dependence on patentably distinguishable base claims 51, 65, 71, 79, 84, 86 and 88.

35 U.S.C. § 103

Claims 89 and 91 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Goetz in view of Liff (U.S. 5,797,515). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

Applicant respectfully submits that there is no motivation or teaching to combine Goetz with Liff. Goetz is directed to a medication management system that involves communication between a doctor and his patient and between the patient and his pharmacist. *See abstract*. Liff, however, is directed to an automated drug dispensing system. *See abstract*. As support for the motivation to combine the references, the Examiner cites to column 5, lines 58-63 of Liff. Applicant respectfully submits that such reliance is misplaced. The cited portion of Liff states “Upon validating the bar-code 98 of the dispensed package 74, the computer generates a label 58 containing prescription information at a label printer 54 to be placed on the package, and generates a document 60 at a document printer 56 containing additional instructions for the patient or practioner.” While this portion of Liff may address the printing of labels and documents for the patient or practioner, this does not address the creation of a “paper prescription” as claimed by Applicant. The reason for this is clear. The medication in Liff has already been prescribed and dispensed when the label and document are created in Liff. Reference to the above-quoted portion of Liff illustrates this point. Liff states that the label can “be placed on the package.” Therefore, Liff does not contemplate the use of a printer to generate paper prescriptions as contemplated by Applicant.

There is no motivation to combine Goetz with Liff. Further, neither Goetz nor Liff, either alone or in combination, teach all of the elements of claims 89 and 91; therefore Applicant submits that the present rejection under 103(a) is improper. Wherefore, claim 12 similarly

overcomes the rejections under 103(a) at least because of its ultimate dependence on patentably distinguishable base claim 89.

Conclusion

In light of the forgoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance.

Respectfully Submitted,



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